

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Goodman et al.

Group Art Unit: 1647

Serial No. 08/971,172

Examiner: Turner, S.

Filed: November 14, 1997

Attorney Docket No. B98-006-2 FAX RECEIVED

For: *Robo: A Novel Family of
Polypeptides and Nucleic Acids*

MAY 08 2003

PETITIONS OFFICE

CERTIFICATE OF TRANSMISSION

I hereby certify that this corr is being transmitted by facsimile to the
Comm for Patents at 703-308-6916 on May 8, 2003.

Signature


Richard Aron OsmanPETITION TO REVISE OR EXPUNGE DECISION OF GROUP DIRECTOR

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

We petition to have the Office of Petitions review and revise or expunge the Decision dated April 28, 2003 because it contaminates this record with numerous misstatements of readily ascertainable facts, improperly burdening and prejudicing the pending review.

For example, at p.3, lines 14-15, the Decision alleges that in pages 6-7 of paper No.27 Applicants "specifically claim that O01632 and U88183 were released on April 21, 1997, and not earlier." We never made this specific claim.

For example, at p.3, lines 17-19, the Decision alleges that in the same paper, Applicants "discount this date by continuing to allege that the sequence of O01632, which includes U88183, was not available until 21 April 1997." We never made this claim and O01632 does not 'include' U88183.

For example, at p.3, lines 27-29, the Decision alleges that in paper no.29, the examiner relies on applicants' arguments "that O01632 contains the same sequence as ... U88183." We never made this argument – the Decision is assigning to us an erroneous remark made by the Examiner.

For example, in the last lines of p.6 the Decision alleges "applicants would have the examiner believe" that the 'last updated' date is not a creation date. This is both factually false and belligerent: we are quite indifferent to what this Examiner believes and have never equated the 'last updated' date with a creation date.

For example, in the sentence bridging p.6 and 7, the Decision alleges that the "last updated" date is "merely the date on which some access or updating of data associated with the sequence was made (such as an additional place where it was discovered...)." This attempt to benignly characterize all sequence updates is factually false: the "last updated" date can also reflect wholesale changes to or substitution of the disclosed sequence itself. Attached is the "BankIt – Genbank update submission form" showing that "updates" may include changes to the disclosed sequence per se.

Despite its boasted "thorough review" (Decision, p.2, line 24), the Decision, like the Actions before it, misapprehends and misrepresents the nature and inter-relatedness of the sequence data of record. This Decision would introduce numerous misrepresentations of readily ascertainable facts, which will confuse and prejudice the pending review. Furthermore, the Decision repeatedly misrepresents our statements in the record. For the third time in this application, we request that if the Examiner (or Mr. Dixon) wishes to rely on our statements in the record, s/he quote them accurately and completely.

As the record shows and as we have repeatedly explained, O01632 is identical in sequence to EMBL/GenBank amino acid entry 1825710, which was generated and submitted by the same authors, but was reportedly released earlier, on Apr 21, 1997. 1825710 (and O01632) appear to encode residues 424-1297 of our SEQ ID NO:6.

Also on Apr 21, 1997, Genbank reportedly released U88183 and 1825711. U88183 (which we made of record in our Response transmitted on 2/7/00) is the sequence of X chromosome cosmid ZK377 and its annotation includes predicted open reading frames, including 1825710 and 1825711. 1825711 appears to encode residues 1-423 of SEQ ID NO:6. Hence, the sequence of natural *C. elegans* robo (SEQ ID NO:6, also known as sax-3, see p.28, line 2 of our specification) comprises a recombination of 1825710 and 1825711. Note that the annotation reference to the Wilson (1994) reference describing a chromosome III cosmid is not for any X chromosome sequence, but merely for methods used to sequence large parts of *C. elegans*

chromosomes.

To the extent that the sequences of the 1825710 and 1825711 predicted reading frames are citeable art under 35USC102(a), our Supplemental Declaration under 37CFR1.131 (made of record with our Response mailed Aug 31, 2000) demonstrates that Applicants had possession of the claimed subject matter prior to their publication. Specifically, the Declaration shows that the full-length sequence encoding *C. elegans* robo (SEQ ID NO:6) was determined by Applicants prior to the April 21, 1997 publication dates of 1825710 and 1825711.

The creation date of an EMBL or GenBank record is not the public availability date. The creation date is the date the record was originally created. Frequently, these records are maintained in secrecy until a predetermined publication or patent filing date is effected. Furthermore, the record at the creation date does not often reflect the record as subsequently accessed. Like most electronic databases, Genbank and EMBL are constantly updating, amending, annotating and otherwise supplementing their records. These newer "editions" retain the creation date of the original record, but were obviously not in existence at that date. Here, the Examiner seeks to rely on a creation date for a record that could not logically have existed on that creation date. A document (electronic or otherwise) that makes explicit reference to dates and events in Apr 1997 and Mar 2000 could not logically have been "published" or made "publically available" in Feb 1997.

The U88183 record has been regularly updated with new annotations since its initial creation. These updates include the annotations of the relevant open reading frames defined by records 1825710 and 1825711. To the extent the Examiner seeks to rely on these annotations, the relevant "publication date" is the date the annotations were made - not the prior creation date of the U88183 record, which at that time did not and logically could not contain reference to the subsequently identified 1825710 and 1825711 reading frames.

If not for all the misrepresentations of fact introduced by Examiner Turner and Mr. Dixon, this would not be a particularly complicated record. Nor is the legal issue complex. All individual genes exist in the prior art as part of natural chromosomes. However, these chromosomes do not anticipate isolated coding regions therein, because the chromosomes are not annotated to characterize all their coding regions. These must be found and determined. There are many examples of Genbank raw sequence submissions of large cosmids, whole

chromosomes, or even entire genomes long before all the individual genes or coding regions of those submissions were identified. As coding regions of these raw genomic sequences are found and determined, the database entries are updated with annotations describing these newly found reading frames. That is the relationship between U88183, the sequence of X chromosome cosmid ZK377, and its subsequently identified reading frame annotations.

The Commissioner is requested to revise or expunge the Decision dated April 28, 2003 so that its representations of fact are consistent with this record.

The Commissioner is hereby authorized to charge any fees or credit any overcharges relating to this communication to my Deposit Account No. 19-0750 (order B98-006-2).

Respectfully submitted,
SCIENCE & TECHNOLOGY LAW GROUP


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encl. BankIt – Genbank update submission form (2p.)

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Bottom Help**Accession Number: [NM_001110]****BankIt -- Update to Existing GenBank Record**

Please check that this is the entry you wish to update, then fill out the information at the bottom of the form to indicate what needs to be changed.

Note! If this is **not** the entry you desired, please back up and select a different accession number.

Please enter the following information to update this entry.

Submitter Information

First name: *Last name:*

Department: *Institution:*

Street:

City: *State/Province:* *ZIP/Postal Code:*

Country:

Phone: *Fax:*

Please include country code for non-U.S. phone numbers.

e-mail:

Update Information

Accession Number: NM_001110

Release Information

May we release this record *before* your paper is published?

NOTE: Sequences must be released when the accession number or any portion of the sequence is published.

Release Immediately Retain Original Hold Date Release Date: June 1 2004 **Author instructions to GenBank staff for this update:**

(e.g. new or changed features or intervals, citation changes or additions, etc.)

Has DNA sequence changed? If so, cut and paste a complete sequence here (30,000 nucleotides maximum - if your sequence is greater than 30,000 nucleotides please e-mail your update to gb-admin@ncbi.nlm.nih.gov). For a range of consecutively numbered sequences, you may change the sequence in some or all of the records in the set by using the following format as shown below:

```
>AF123456
gagagttat...
>AF123457
tgggtgtac...
>AF123458
cagtccgtat...
```

Has Protein information changed? If so, cut and paste complete protein sequence here. If the submission has more than one protein sequence, please provide enough information to unambiguously map each protein to its correct DNA interval. You may change the sequence in some or all of the records in the set by using the following format as shown below:

```
>AF123456
MSTDAEMA...
>AF123457
MEAREKET...
>AF123458
MSSDQEEMA...
```

When you are done entering information, press the **BankIt** button to send your update to GenBank.